

REMARKS

STATUS OF CLAIMS

The Office Action dated October 17, 2003 has been received and its contents carefully considered. Claims 3-12 and 17-20 are pending. Claims 3, 8 and 17 are independent. The Examiner is thanked for the telephonic interview on February 12, 2004 in which it was agreed to file this request for reconsideration based on both the Examiner's remarks in response to arguments of the previous amendment filed September 23, 2003 and the lack of structural teachings in the cited prior art with regard to the "temperature sensor connected to the evaporator" claimed structure.

- Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

OFFICE ACTION

Claims 3-12 and 17-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Kanai '921 in view of Marshall et al. '891. This rejection is respectfully traversed with respect to the following reasons.

Without conceding the propriety of the rejections, claim 3 recites, *inter alia*, said sensors are temperature sensors which are connected to said evaporator. Kanai '921 shows in FIGS. 1, 3, 6 and 9 a system for testing refrigeration units which lacks the structure of temperature sensors connected to the evaporator. Marshall et al. '891 teaches the structure of placing temperature sensors only in an air stream of exhaust air (at 168, 172 & 198, 200 & 216, 220 & 218, 248) and is silent on the presently claimed structure of connecting temperature sensors to an evaporator. In accordance with the M.P.E.P. §2143.03, to

establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re: Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re: Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494 196 (CCPA 1970). However, neither Kanai ‘921 nor Marshall et al. ‘891 teach or suggest the structural connections and elements claimed in the present invention, in particular, the structure and limitation of said sensors are temperature sensors which are connected to said evaporator. Thus, it cannot be said that Kanai ‘921 in combination with Marshall et al. ‘891 teaches or suggests the invention as presently claimed.

In addition, claim 8 recites, *inter alia*, said sensor means is a temperature sensor.

- Kanai ‘921 shows in FIGS. 1, 3, 6 and 9 a system for testing refrigeration units which lacks the structure of temperature sensors connected to the evaporator. For anticipation under 35 U.S.C. §102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02). Since each and every element, as set forth in the claim, is not found either expressly or inherently described as required by the M.P.E.P, Kanai ‘921 cannot be said to anticipate the test system for simultaneously testing a plurality of heat pumps as claimed. Thus, it cannot be said that Kanai ‘921 teaches or suggests the invention as presently claimed.

Moreover, claim 17 recites, *inter alia*, said sensors are temperature sensors coupled to the evaporator of said heat pumps. Kanai ‘921 shows in FIGS. 1, 3, 6 and 9 a system for testing refrigeration units which lacks the structure of temperature sensors

connected to the evaporator. Marshall et al. '891 teaches the structure of placing temperature sensors only in an air stream of exhaust air (at 168, 172 & 198, 200 & 216, 220 & 218, 248) and is silent on the presently claimed structure of coupling temperature sensors to an evaporator. In accordance with the M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re: Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re: Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494 196 (CCPA 1970). However, neither Kanai '921 nor Marshall et al. '891 teach or suggest the structural connections and elements claimed in the present invention, in particular, the structure and limitation of said sensors are temperature sensors coupled to the evaporator of said heat pumps. Thus, it cannot be said that Kanai '921 in combination with Marshall et al. '891 teaches or suggests the invention as presently claimed.

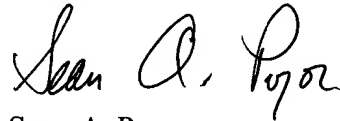
For the foregoing reasons, it is respectfully submitted that the invention recited in claims 3, 8 and 17 is patentable over Kanai '921 taken alone or in combination with Marshall et al. '891. Thus, it is respectfully submitted that the remaining depending claims are allowable for at least the reasons given herein.

In view of the foregoing, reconsideration and allowance of the application are believed in order, and such action is earnestly solicited.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned at 202/861-1748.

Respectfully submitted,

BAKER & HOSTETLER LLP

A handwritten signature in black ink, appearing to read "Sean A. Pryor". The signature is fluid and cursive, with the first name "Sean" and last name "Pryor" clearly distinguishable.

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